

## **REMARKS**

Applicant is in receipt of the Office Action mailed February 15, 2006. Claims 1 – 31 were rejected. Claims 20 – 23 have been amended. Claims 1 – 31 remain pending in the application.

Applicant has amended claims 20 – 23 primarily to modify the grammar and formatting. No new issues are believed to be raised by the amendments, and entry of the amendments is respectfully requested.

### **Section 103(a) Rejections**

Claims 1, 4, 10, 13, 15, 20, 23, 25, 26, 29, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien (PCT No. WO0857474) in view of Walters (U.S. Patent No. 5,357,573). Claims 2, 11, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of Braithwaite (U.S. Patent No. 5,644,444). Claims 3, 12, 22, 27, and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of Hellman et al. (U.S. Patent No. 4,200,770), hereinafter “Hellman.” Claims 5, 14, 24, and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of “Windows NT Server.” Claims 6, 7, and 16 – 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of Combaluzier (U.S. Patent No. 5,973,475). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of Teppler (U.S. Patent No. 6,792,536). Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and further in view of Hastings et al. (U.S. Patent No. 5,460,411), hereinafter “Hastings.” Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Merrien in view of Walters and Combaluzier and further in view of Teppler. Applicant respectfully traverses the rejections in light of the following remarks.

Merrien discloses a method and a system for using a smart card capable of being inserted in a terminal. Merrien further discloses storing in the card an Internet provider's address, an IP address, and the card user's other personal Internet data; inserting the card in a card reader connected to the terminal; and activating an explorer to use the personal Internet data when the terminal is connected to the Internet.

Walters discloses a memory card (such as a PCMCIA card) which protects against unauthorized copying and use of software saved on the card. A read-only protection code is stored in the memory card. The protected software is supplemented by a protection routine which is activated upon execution of the software. The protection routine reads the protection code from the memory card and compares it to a comparison code contained within the protection routine. Use of the protected software will be allowed only if the two codes match.

Applicant's claim 1 recites, in pertinent part:

A processing unit connectable to a data communications network, the processing unit having a device reader for a portable storage device that includes storage operable to supply a network identity for the processing unit and an access controller, the access controller being operable to prevent unauthorized writing to the storage, the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity.

In order to reject a claim as obvious, the Examiner has the burden of establishing a *prima facie* case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). As stated in the section 2143 of the MPEP (Eighth Ed., Rev. 2), three basic criteria must be met to establish a *prima facie* case of obviousness: "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or

suggest all the claim limitations.” With respect to claim 1, Applicant respectfully submits that the Examiner has not established a *prima facie* case for combining the cited references.

First, there is no suggestion or motivation to combine the references. The showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular .... Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). As held by the U.S. Court of Appeals for the Federal Circuit in *Ecolochem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. With respect to claim 1, the Examiner argues that the motivation to combine Merrien and Walters is “to verify that the card input to the system was an approved card that could be used with the system.” The Examiner cites various locations in Walters (col. 2, lines 31 – 35; col. 2, line 60 to col. 3, line 3; col. 4, line 62 to col. 5, line 51) as including this motivation. However, there is no teaching either in the references cited or in the prior art to show how to combine the elements of Merrien with the elements of Walters to produce the claimed invention. Accordingly, Applicant submits that the obviousness rejection is defective as hindsight analysis.

Additionally, there is no reasonable expectation of success because the references cited by the Examiner teach away from each other. Merrien discloses a card which stores an IP address. The IP address openly and visibly identifies Merrien’s system on a computer network. By contrast, Walters discloses a card which stores a protection code. The code is strictly for internal use to ensure that copying or use of software is authorized. Making this code public, such as by using it as a network identity, would jeopardize the security of the code and thus undermine the security scheme disclosed by Walters.

Furthermore, Applicant respectfully submits that the cited references, singly or in

combination, do not teach or suggest all the limitations of claim 1. In particular, the cited references do not teach or suggest “the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity.” The Office Action admitted that Merrien does not teach or suggest this limitation and instead cited Walters. At col. 5, lines 15 – 21, Walters discloses:

It is however possible to include a program routine in the BIOS of the specific PC which can read from the read-only memory device. This routine will initially attempt to write to this memory area. When this does not succeed the protection code will be read to guarantee that it is dealing with a functional protection code.

The protection code in Walters is intended only for internal use by the protection routine in the protected software. The protection code does not supply any information which is used outside of the authorization procedure. In particular, the protection code does not supply a network identity usable for access to a data communications network by a processing unit. The Final Office Action argued that the network identity comprises other data which can be read after the write-then-read technique of Walters is performed. However, Walters actually discloses a protection code which is usable to allow the execution of software associated with the particular protection code. There is no teaching or suggestion in Walters that verification of the protection code permits the reading of arbitrary data (i.e., data other than the executed software, such as the network identity of Merrien) from the card. Applicant therefore submits that the cited references, taken individually or in combination, do not teach or suggest “the processing unit being operable, before reading the network identity from the portable storage device, to attempt a write to the storage of the portable storage device, and, on determining that the write has failed, to read the supplied network identity” as recited in claim 1.

For at least the reasons discussed above, Applicant respectfully submits that independent claims 1, 10, 20, and 25 are patentably distinct from the cited references. The remaining dependent claims provide additional limitations to the independent claims.

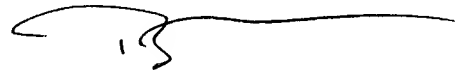
Therefore, Applicant submits that claims 1 – 31 are in condition for allowance. Applicant respectfully requests withdrawal of the §103(a) rejections.

### CONCLUSION

In light of the foregoing amendments and remarks, Applicants submit that all pending claims are now in condition for allowance, and an early notice to that effect is earnestly solicited. If a phone interview would speed allowance of any pending claims, such is requested at the Examiner's convenience.

The Commissioner is authorized to charge any fees which may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/5681-04100/BNK.

Respectfully submitted,



B. Noël Kivlin  
Reg. No. 33,929  
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin,  
Kowert & Goetzel, P.C.  
P.O. Box 398  
Austin, Texas 78767-0398  
Phone: (512) 853-8840

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